

REMARKS

Upon entry of the present amendment, claims 1-3 and 5-8 will remain pending in the above-identified application and stand ready for further action on the merits.

Claim 1 has been amended to include limitations previously recited in claim 4. Claim 4 has been cancelled to prevent a redundancy with amended claim 1. Claims 5-8 have been added.

The present amendments to the claims do not introduce new matter into the application as originally filed. For example, support for the newly added claims 5-8 can be found in the present specification at page 6, lines 11-12 (claim 5), page 5, lines 14-21 (claim 6), page 5, lines 10-13 (claim 7) and page 5, line 22 through page 6, line 2 (claim 8).

Claim Rejections under 35 USC § 102(b)

Claims 1 and 3 are rejected under 35 USC § 102(b) as being anticipated by **Behringer US '957** (US 3,447,957).

Applicants respectfully submit that this rejection has been overcome by the present amendments to the claims, since independent claim 1 now recites limitations previously occurring in claim 4.

Inasmuch as prior claim 4 was not rejected under 35 USC § 102(b) over the Behringer US '957 reference, it follows that instantly amended claim 1 and dependent claims 2-3 and 5-8 that ultimately depend from claim 1 are all novel over the Behringer US '957 reference. Any contentions of the USPTO to the contrary must be reconsidered at present.

Claim Rejections under 35 USC § 103(a)

Claims 1-4 are rejected under 35 USC § 103(a) as being unpatentable over **Kimura et al.** US '033 (US 6,407,033) in view of **Behringer US '957** (US 3,447,957).

Reconsideration and withdraw of this rejection is respectfully requested based on the following considerations.

Legal Standard for Determining Prima Facie Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.).

“In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The Supreme Court of the United States has recently held that the teaching, suggestion, motivation test is a valid test for obviousness, but one which cannot be too rigidly applied. See *KSR Int’l Co. v. Teleflex Inc.*, 127 SCt 1727, 82 USPQ2d 1385 (U.S. 2007). The Supreme Court in *KSR Int’l Co. v. Teleflex, Inc.*, *ibid.*, reaffirmed the Graham factors in the determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under Graham are:

- (a) determining the scope and contents of the prior art;

- (b) ascertaining the differences between the prior art and the claims in issue;
- (c) resolving the level of ordinary skill in the pertinent art; and
- (d) evaluating evidence of secondary consideration.

Graham v. John Deere, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (U.S. 1966).

The Court in *KSR Int'l Co. v. Teleflex, Inc.*, *supra.*, did not totally reject the use of "teaching, suggestion, or motivation" as a factor in the obviousness analysis. Rather, the Court recognized that a showing of "teaching, suggestion, or motivation" to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

Even so, the Court in *KSR Int'l Co. v. Teleflex, Inc.*, *ibid.*, rejected a rigid application of the "teaching, suggestion, or motivation" (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject matter to be obvious.

Accordingly, while the courts have adopted a more flexible teaching, suggestion, motivation (TSM) test in connection with the obviousness standard based on the *KSR v. Teleflex* case, which case involved a mechanical device in a relatively predictable technological area, it remains true that, despite this altered standard, the courts recognize inventors face additional barriers in relatively unpredictable technological areas as noted in *Takeda Chemical Industries, Ltd. v. Alphapharm Pty., Ltd.*, 83 USPQ2d 1169 (Fed. Cir. 2007).

Further, the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336, quoted with approval in *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007).

Distinctions Over the Cited Art

The Examiner refers to adhesives disclosed by Kimura US ‘033. However, Kimura US ‘033, discloses silicon-modified resin, not shellac resin as in the present invention.

As shown in page 2, lines 15-22 of the present specification, a rigid film is formed on the substrate surface by using conventional resins for cloth or the like. Accordingly, there is obtained a defect, in that the feel of the substrate is lost. Whereas in contrast, the resins disclosed by Kimura US ‘033 are most suitable in terms of forming film, toughness and adhesion (*see column 9, lines 39-47*).

As such, it is never expected by one of ordinary skill in the art upon considering the teachings of Kimura US ‘033 to achieve the technical idea of the instant invention that feel and flexibility can be maintained, although the photocatalyst is deposited on the surface of the cloth or the like (*as occurs in the present invention*).

Behringer US ‘957 discloses shellac resin as one of many examples of adhesives for which substrate is glass plate etc. Thus, the invention of Behringer is quite different from the present invention and its combination with the primary reference of Kimura US ‘033 is incapable of providing any reason or rationale for one of ordinary skill in the art to arrive at the instant invention as claimed.

Any contentions of the USPTO to the contrary must be reconsidered, since the outstanding rejection over Kimura US '033 in view of Behringer US '957 is not sustainable.

CONCLUSION

Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of pending claims 1-3 and 5-8 are allowed and patentable under the provisions of Title 35 of the United States Code.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: November 19, 2007

Respectfully submitted,

By 

John W. Bailey

Registration No.: 32,881

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant